



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,970	01/25/2002	Teddy M. Keller	82,942	8822

26384 7590 07/31/2003

NAVAL RESEARCH LABORATORY
ASSOCIATE COUNSEL (PATENTS)
CODE 1008.2
4555 OVERLOOK AVENUE, S.W.
WASHINGTON, DC 20375-5320

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.

10/054,970

Applicant(s)

KFULLER ET AL.

Office Action Summary

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/6/03 Rspnse.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 21-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-38 is/are allowed.
- 6) ☒ Claim(s) 7-11 and 13-17 is/are rejected.
- 7) ☒ Claim(s) 8, 13-20 and 39-45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1 ☐ Certified copies of the priority documents have been received.
- 2 ☐ Certified copies of the priority documents have been received in Application No. _____.
- 3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1712

DETAILED ACTION

1. Applicants' election in response to the restriction requirement filed on June 6, 2003 was received. Group II (Claims 7-12 and 35-38) is elected with traverse. In view of Applicants' argument, Examiner has reconsidered the restriction requirement regarding the instant application and has decided to give an action on the merits for Group II (Claims 7-12 and 35-38) as well as Group III (Claims 13-20 and 39-45)

2. Claims 1-6 and 21-34 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

The requirement is still deemed proper and is therefore made FINAL.

3. The followings are Examiner's suggestions/questions:

In Claims 9-10, 16-17, 36-37 and 40-41, should "functional" be deleted because Ar₁, Ar₂ are R do not contain any reactive groups and are conventionally not considered as functional groups?

Claim Objections

4. Claims 8, 15, 13-20 and 39-45 are objected to because of the following informalities:

In Claims 8 and 15, should "1,4-butadiyne" be -- 1,4-butadiynyl --?

Art Unit: 1712

In Claims 13 and 39, the term "crosslink density" causes confusion because crosslink density is conventionally refers to the extent of crosslinking, and is typically expressed as number of crosslinking sites per volume, gram, etc.

Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 7-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 9-11 of U.S. Patent No. 6 362 289.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons: When n is 0 in Claims 1, 5, 9 and 11 of US 6 362 289, the instant claims obviously individually read on Claim 7 of the present invention. When n is 0, Claim 2 of US 6 362 289 obviously reads on Claim 8 of the present invention. When n is 0, Claim 3 of US 6 362 289 obviously reads on Claim 9 of the present invention. When n is 0,

Art Unit: 1712

Claim 4 of US 6 362 289 obviously reads on Claim 10 of the present invention. When n is 0, Claim 10 of US 6 362 289 obviously reads on Claim 11 of the present invention.

7. Claims 13-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 9-11 of U.S. Patent No. 6 579 955. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons: When n is 0 in Claims 1, 5 and 9 of US 6 579 955, the instant claims obviously individually read on Claims 13 and 14 of the present invention. When n is 0, Claim 2 of US 6 579 955 obviously reads on Claim 15 of the present invention. When n is 0, Claim 3 of US 6 579 955 obviously reads on Claim 16 of the present invention. When n is 0, Claims 4 and 10-11 of US 6 579 955 obviously individually reads on Claim 17 of the present invention.

8. Claims 7, 13 and 39 would be allowable if rewritten or amended to overcome the claim objection and/or the double-patenting rejection, set forth in this Office action.

Wu (US 3 325 530) discloses a polymer containing silarylene units and siloxane units and a process for preparing the polymer (Example I). However, Wu does not teach or fairly suggest that the polymer contains acetylene units and specific repeating units of $-(O-SiR_2-Ar_2-SiR_2-O-SiR_2-Ar_1-SiR_2)-$ set forth in the present invention.

Art Unit: 1712

9. Claims 8-10, 14-20 and 40-45 would be allowable if rewritten to overcome the claim objection and/or the double-patenting rejection, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The patentability of the instant claims is described in paragraph 8.

10. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The patentability of the instant claims is described in paragraph 8.

Allowable Subject Matter

11. Claims 35-38 are allowed.

12. The following is an examiner's statement of reasons for allowance:

The patentability of the instant claims is described in paragraph 8.

13. In the second reference of the second page of the information disclosure statement filed on January 25, 2002, the starting page number of the article has been changed from "3502" to "3508" as showing in the hard copy provide by Applicants.

Art Unit: 1712

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp
July 24, 2003


Kuo-Liang Peng
Art Unit 1712